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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/840,077	04/24/2001	Patrick Michael McCaffrey	ROC920010057US1-IBM 204	2562
7590 10/21/2003			EXAMINER	
Robert H. Berdo, Jr. RABIN & CHAMPAGNE, P.C. Suite 500 1101 14th Street, N.W. Washington, DC 20005			OJINI, EZIAMARA ANTHONY	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 10/21/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/840,077

Applicant(s)

MCCAFFREY ET AL.

Examiner

Anthony Ojini

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 October 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 10-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is hereby withdrawn.

Applicant's election with traverse of Group I, claims 1-9 in Paper No. 5 are acknowledged. Claims 10-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. The traversal is on the ground(s) that "examination of the entire application would not constitute a serious burden on the part of the Examiner, since the Examiner has already searched the subject matter of the claims of both Groups I and II". This is not found persuasive because the process for using the product as claimed could be practiced with another materially deferent product such as glass lens that does not require powder disposed between stacked lenses.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abiko (JP 10208301 A) in view of Kobayashi (6,601,289).

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**With respect to claims 1, 9,** Abiko discloses a plurality of disks (12,13), stacked that are spaced apart and a powder disposed between the disks (see the abstract).

Abiko fails to disclose the powder is for facilitating removal of the first disk from the second disk, and protecting the first disk and the second disk when the second disk is stacked upon the first disk. Abiko also fails to disclose the first disk is spaced apart from the second disk by only the powder.

Kobayashi discloses a powder ceramic board (9) inserted between two disks (15,15') for preventing the disks from sticking each other (col. 7, lines 27-30; and col.8, lines 22-24).

Kobayashi also disclose the first disk is spaced apart from the second disk by only the powder (see fig. 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Abiko with a powder disposed between two disks in view of Kobayashi so as to prevent the disks from sticking each other.

It has also been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

**With respect to claim 2,** Abiko fails to disclose each disk comprises a glass and a glass-ceramic.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Abiko with a glass disk and a glass-ceramic, since it has been held to be within the general skill of a worker in the art to select a

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known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

**With respect to claim 3**, Abiko discloses a plurality of disks, stacked **12,13** that are spaced apart and a powder disposed between the disks.

**With respect to claims 4-7**, Abiko fails to disclose mineral powder comprising an inorganic material that is selected from the group consisting of carbonate, calcium magnesium carbonate, calcium phosphate, magnesium carbonate, magnesium borate, magnesium oxide, magnesium phosphate, and clay.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Abiko with a powder disposed between the disks, which is comprised of an inorganic material that is selected from the group consisting of carbonate, calcium magnesium carbonate, calcium phosphate, magnesium carbonate, magnesium borate, magnesium oxide, magnesium phosphate, and clay, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

**With respect to claim 8**, Abiko fails to disclose the optimum value as claimed by the applicant. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide product of Abiko with the optimum value as claimed by the applicant, since it has been held that discovering an optimum value of a result

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effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305 3768. The examiner can normally be reached on 7.30 to 5.00 Tuesday-Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 3590 for regular communications and 703 746 3277 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.



Joseph J. Hail, III  
Supervisory Patent Examiner  
Technology Center 3700

AO  
October 19, 2003